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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,900

Applicant(s)

PINZON ET AL.

Examiner

JYOTHSNA A VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 321,322,325,330,334,335,337,338 and 348-368 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 321,322,325,330,334,335,337,338 and 348-368 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/7/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

The examiner of this application is changed from Marina Lamm to Jyothsna Venkat.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/2004 has been entered.

Applicants are notified that the restriction requirement dated 3/26/02 is rescinded. Claims 1-320, 323-324, 326-329, 331-333, 336, 339-347 are canceled and claims 348-369 are added.

Claims 362-369 are renumbered as claims 361-368 (Rule 126). Claims 321-322, 325, 330, 334-335, 337-338, and 348-368 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 355-369 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the specification for the structuring polymer species, which are “ethylenediamine/stearyl dimmer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer”.

Applicants in the response dated 9/7/04 point out support for the species to specification at page 12 which describes Uniclear^R and submit exhibit 1, which is “International Cosmetic Ingredient Dictionary and Handbook” which describes Uniclear as the two species. It is the examiners position that the documentation is not a competent documentation. Applicants filing date is December 12, 2000 and the document publication date is later than the instant filing date. Therefore the recitation of the species is new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 325, 330, 334, 337, 338, 349-354, 356-358, 360, 361, and 363-368 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The expression “treatment composition” lacks clarity, as the specification does not define the scope for the expression “treatment”.

The expression “method for providing resistance to shear” also lacks clarity, as the specification does not define the scope for the expression “resistance to shear”. According to the Webster’s Dictionary, the meaning of shear is “to cut”. Therefore how can one provide “resistance to cut “in a cosmetic composition? Detailed explanation is requested and competent

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documentation that “ resistance to shear “ is accepted in the cosmetic art would be given careful consideration.

The specification at page 13 describes the polymer as Versamid. The specification describes that more information can be deduced from the patents 3,645,705 and 3,148,125 125. The patents '705 and '125 do not give the structure .Is Versamid the species of formula I claimed in the instant application? If applicants respond that Versamid is within the scope of formula I then the next office action would be non- final based upon the patent 6,423,324 ('324) since patent '324 discloses Versamid, cationic surfactant and coloring agent claimed in the compositions. Therefore the patent anticipates the composition claims (102 (e)).

The rejection of claims 321-322, 325, 330, 334-335, 337-338, and 348-354 under 35 U. S. C. 103 over U. S. Patent '657 in view of U. S. Patents '324 and '483 is maintained for reasons of record.

Response to Arguments

7. Applicant's arguments filed 9/7/04 have been fully considered but they are not persuasive.
8. Applicants argue that there is no motivation in either patent '857 or '324 to combine at least one oil-soluble surfactant with the polyamide gelling agent and one of ordinary skill in the art would fail to find such motivation in the patent '324 since the patent discloses cationic surfactants as the non-preferred embodiment and fails to disclose oil-soluble surfactants.
9. In response to the above argument, it is the position of the examiner that the patent '657 teaches the same polyamide polymers as gelling agents and at col.14, lines 38-43 teaches the application of this gellant in various cosmetic personal care products and the patent '324 suggest

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the combination of the polyamide resin and also cationic surfactant and one of ordinary skill in the art would be certainly motivated to combine the ingredients. The patent at the paragraph bridging cols. 8-9 teaches to one of ordinary skill in the art that the composition can include blend of surfactants and the patent at col.10 definitely teaches to one of ordinary skill in the art that in addition to non-ionic surfactants, cationic or anionic surfactants can be used.


10. Applicants did not address the rejection with respect to patent '483 which teaches the specific oil-soluble surfactant claimed in the instant application. In summary, it is the position of the examiner that the patent '657 teaches the specific structuring polymer as the gelling agents and the patent '324 teaches the combination of the polyamide resin (structuring polymer) along with cationic surfactants and the patent '483 teaches that the combination of non-ionic and cationic surfactants which can be oil soluble provide outstanding properties. Therefore one of ordinary skill in the art would certainly be motivated to combine the structuring polymer and substitute the oil soluble cationic surfactant of '483 for the cationic surfactant in the compositions of '324 with the reasonable expectation of success that the compositions exhibit outstanding properties. The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. Therefore the subject matter as a whole is obvious within the meaning of 35 U. S. C. 103 over the combination of the patents '657, '324 and '483.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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